

REMARKS

By the present communication, claims 1-6, 9-12, 26, 27, 36-38, and 53-55 are amended, claims 52 and 63 are canceled, and claims 65 and 66 are new. No new matter is introduced by the amendment as the amended and new claim language is supported by the application as originally filed. Specifically, support for new claims 65 and 66 may be found in original claim 53 and paragraphs 23 and 60. A complete listing of the claims as currently pending, with appropriate status identifiers included, is found on pages 3-13 of this document. After entry of the claim amendments, claims 1-38, 49-51, 53-62, and 64-66 will be pending in the application.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendment and in view of the reasons that follow.

I. Examiner Interview Summary

Applicant's Representative thanks Examiner Anderson for engaging in a telephonic interview on October 31, 2007. Drs. J. Meara and J. Lomprey were present on behalf of the Applicant. During the interview the use of "about" in the claims was discussed, as well as the obviousness-type double patenting (ODP) rejections. Applicants indicated that "about" would be deleted from the claims in regard to modifying the claimed ranges of C_{\max} and AUC, and the Examiner indicated that would be acceptable. The ODP rejections were also discussed at length, and Applicants further elucidate their position below.

II. Rejections Under 112, Second Paragraph

Claims 1-38 and 49-64 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for the use of the term "about." As stated above, the term has been deleted from the claims at each occurrence. Applicants request withdrawal of the rejections.

III. Double Patenting

A. U.S. 6,605,617

Claims 1-38 and 49-64 remain rejected on the grounds of ODP as allegedly being unpatentable over claim 30 of co-pending U.S. Patent No. 6,605,617 (the '617 patent). Applicants respectfully traverse this rejection.

The standard for the analysis employed in an ODP determination parallels that of a 35 U.S.C. § 103(a) rejection (M.P.E.P. 804(II)(B)(1), citing *In re Braat*, 937 F.2d 589 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887 (Fed. Cir. 1985); and *In re Braithwaite*, 379 F.2d 594 (CCPA 1967)). Thus, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and reaffirmed in *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007) apply to the ODP analysis. However, as acknowledged in the M.P.E.P. § 804(III),

[o]ne significant difference [between an ODP rejection and a 102(e)/103(a) rejection] is that a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an anticipation or obviousness rejection...relies on a comparison with what is disclosed (whether or not claimed) in the same issued or to be issued patent.

(Emphasis added.)

Hence, a proper ODP rejection, must be based on an analysis that is analogous to that of an obviousness rejection under 35 U.S.C. § 103, but relies on what is taught in the *claims* of the cited patent. Indeed, the MPEP at 804(II)(B)(1) describes the factual inquiries as:

- A) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;
- C) Determine the level of ordinary skill in the art;

D) Evaluate any objective indicia of nonobviousness.

(Emphasis added)

Applicants submit that the present rejections fail to establish the obviousness of the claimed methods, for at least two related reasons. First, in view of the reference claims alone, the presently claimed methods recite a non-obvious selection of the claimed compounds, and second, in view of the reference claims alone, the presently claimed methods recite a non-obvious selection of blood and/or plasma ranges.

1. A Selection of the Claimed Compounds

The presently claimed invention is a selection invention with regard to the specific compounds claimed in independent claims 1, 9, 36, 49, and 53. Claim 30 of the '617 patent is directed to a broad genus, with no specific mention of the individual compound of claim 1, or the compounds of claim 53. Claim 30 of the '617 depends from claim 29, which in turn depends from each of claims 1, 8, 15, and 22. Thus, claim 30 is directed to methods that recite an extremely large number of compounds, but which provide no guidance to select the compound of present claim 1 from the multitude of possible compounds. Such selection inventions were found by the Federal Circuit to be patentably distinct in *In re Baird*, 16 F.3d 380, 29 U.S.P.Q.2d 1550 (Fed. Cir. 1994).

The invention in *Baird* covered a flash fusible toner comprising a polyester of bisphenol A and an aliphatic dicarboxylic acid. The Board affirmed the examiner's obviousness rejection on grounds that the prior art reference specifically disclosed compositions comprising esters of three dicarboxylic acids claimed and a generic diphenol formula that encompassed bisphenol A. Although Baird argued that the reference lacked motivation to select bisphenol A, the Board disagreed, concluding that the generic disclosure of the reference provided ample motivation to select the claimed bisphenol A polyester binder resin in arriving at the claimed composition. *In re Baird*, 16 F.3d at 382, 29 U.S.P.Q.2d at 1551.

Before the Federal Circuit, the parties did not dispute that the generic diphenol formula of the cited reference encompassed bisphenol A. Nor did Baird dispute that the reference specifically disclosed the three dicarboxylic acids recited in the appealed claim. *Id.*

Nonetheless, the court reversed the decision of the Board, holding that a generic formula does not by itself necessarily render a compound encompassed by that formula obvious. *Id.* at 382, 29 U.S.P.Q.2d at 1552 (emphasis added). Noting that the generic formula of the diphenol encompassed more than 100 million different diphenols, the court found no suggestion in the reference to select the particular combination of variables in that formula that would give rise to bisphenol A. *Id.* at 382-83, 29 U.S.P.Q.2d at 1552.

Similar to *Baird*, and as described above, a very large genus of compounds is described by the '617 patent, and as in *Baird*, Applicants do not deny that the compounds recited in the present independent claims are encompassed by the broad claims of the '617 patent. However, notably, the '617 patent fails to provide any guidance *in the claims*, to select the three compounds of the presently claimed invention. With such a broad genus of compounds described by the '617 patent, and the specific claiming of a single species (in this case 3 species) specifically being allowed by the Federal Circuit's holding in *In re Baird*, Applicants submit that the present rejection cannot stand.

2. *A Selection of the Blood Levels*

The presently claimed invention is also a selection of a specific range of C_{\max} and AUC values that are to be achieved in the blood of a subject after administration. As the Examiner points out, "claim 30 of '617 is so broad so as to include administration of any amount of the claimed compounds to treat a VEGF mediated disease..." Office Action, page 5 (emphasis in original). In contrast, Applicants have claimed a narrower range of C_{\max} and AUC values, as opposed to any amount as characterized by the Examiner with regard to the '617 patent. Moreover, the ranges set forth in many of the dependent claims are even narrower than claim 1 and cannot be rendered obvious merely based on the disclosure of claim 30 in the '617 patent.

This particular selection invention goes further than the mere selection of a range of values, and instead describe amounts not taught or suggested by the claims of the '617 patent. Nowhere in the claims of the '617 patent (or in the specification for that matter) is reference made to a preferred or desired value for C_{max} and AUC. In the presently claimed invention, the Applicants have determined such values and dosages corresponding to such values and recite said values in the claims. Based upon these observations, it is apparent that the '617 patent does not teach or suggest the claimed compounds and blood/plasma ranges, and therefore, the '617 patent cannot render the claims obvious.

3. *Additional Reasons*

Further, in regard to Claim 53 and claims depending therefrom, Applicants reiterate the traversal of the rejection as stated in the response dated March 2, 2007. In brief, Applicants again draw the Examiner's attention to the fact that nowhere in claim 30 or any other claim of the cited patent (or, for that matter, in the specification of the '617 patent) are the metabolite compounds of Formula II or III disclosed (4-amino-5-fluoro-3-[6-(piperazin-1-yl)-1H-benzimidazol-2-yl]quinolin-2(1H)-one and 4-amino-5-fluoro-3-[6-(4-methyl-4-oxido-piperazin-1-yl)-1H-benzimidazol-2-yl]quinolin-2(1H)-one, respectively). Nor is there a teaching or suggestion of exposing a human subject to the compounds of formula II and/or formula III or the specific blood levels recited in Claim 53. Also, as discussed during the interview, the metabolite compounds of Formulas II and III have been observed in rats, but the same metabolites have *not*, to date, been observed in human subjects. Therefore, the claims that specifically call for exposure of a human subject to the compounds of Formulas II or III, have absolutely no basis in the claims of the '617 patent, or in the specification, and as such, the '617 patent does not obviate the presently presented claims.

However, as indicated in the present specification, the metabolite compounds of Formulas II and III do have efficacy in treating cancer by exposing a subject to the compounds recited in claim 53. Without a teaching or suggestion of one or both of these compounds, Applicants submit that there can be no teaching or suggestion of administering or exposing a

subject to one or both of the compounds. Furthermore, without such a teaching or suggestion, one of ordinary skill in the art would not be cognizant of what to look for, or at what concentration to measure the provided blood and plasma ranges. There is no suggestion or teaching in claim 30 of the '617 patent of each and every element of claims 52 and 53, as presented. Applicants point out that new claims 65 and 66, depend from claim 53 and specifically call out the two metabolites described above.

For the reasons above, Applicants respectfully submit that no basis exists for the obviousness-type double patenting rejection of claims 1-38 and 49-64 over claim 30 of the '617 patent. Applicants respectfully request that the Examiner reconsider and withdraw the noted rejection.

B. U.S.S.N. 10/886,950

Claims 1-7, 9-12, 14, 25-30, 36-38, and 52-64 currently stand rejected on the grounds of obviousness-type double patenting over claims 13, 16, and 17 of co-pending application USSN 10/886,950. Applicants point out that claim 16 of the '950 application is currently shown in the prosecution history as having been canceled. Thus, Applicants believe the recitation of claim 16 to be error, and will assume that the rejection is entirely based upon claims 13 and 17.

As discussed during the interview with the Examiner, the '950 application is currently considered to be abandoned by the USPTO. Applicants are in the process of petitioning for withdrawal of the abandoned status, and intend to appeal the final rejection once the application is revived. Hence, Applicants address the rejections above, on the merits, and respectfully traverse the noted rejections.

The rejection of the claims based upon the '950 application is premised on the assumption that the disclosure of administering a compound to a subject is obviating of the presently presented claims directed to specific C_{max} and AUC values. The Examiner has asserted that because "the administration of the claimed compound in any dose to treat cancer," is

encompassing of the presently claimed ranges, that the claims are obvious. Office Action, page 6. However, the Examiner has not acknowledged the selection of a small subset of any dose.

As with the argument presented above for the '617 patent, claims 1-7, 9-12, 14, 25-30, 36-38, and 53-64 are a selection invention that Applicants assert is patentable over claims 13, 16, and 17 of the '950 application. As described above with regard to the '617 patent, this situation is analogous to the set of facts faced by the court in *In re Baird*. Here, Applicants have claimed a range of C_{\max} and/or AUC values that is a smaller subset of the seemingly infinite number of doses that could conceivably produce such values. Applicants do not deny that there is a dose in the genus of any doses, that would fall within the presently claimed ranges. However, there is no instruction in either of claims 13 or 17 of the '950 application, which would teach or suggest the presently claimed ranges. Thus, as in *Baird*, the very broad genus fails to render the smaller subset obvious. Applicants respectfully request withdrawal of the provisional ODP rejection.

C. U.S.S.N. 11/342,257

Claims 1-14, 25-30, 36-38, and 52-64 stand provisionally rejected for ODP over claims 1-5, 7-8, 10-17, 19-20 and 22 in co-pending U.S.S.N. 11/342,257, filed on January 27, 2006 (the '257 application). As the '257 application is still pending, the ODP rejection over the '257 application remains provisional.

Applicants respectfully submit that the procedure set forth in § 804(I)(B)(1) of the M.P.E.P. is applicable to the present provisional double-patenting rejections. Section 804(I)(B)(1) of the M.P.E.P. states that

[i]f a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw the rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

Applicants note that the instant application has an earlier filing date than the '257 application.

Because Applicants believe that, after entry of the above amendments and consideration of the remarks herein, no other rejections will remain in the present application, it is respectfully requested that the Examiner withdraw the provisional ODP rejection of claims 1-14, 25-30, 36-38 and 52-64 over the '257 application (i.e. the later filed application), and allow this application to move forward to issuance. Applicants make no admission regarding the propriety of the double patenting rejection in this application over U.S.S.N. 11/342,257 and specifically reserve the right to challenge the propriety of this rejection, should it be maintained or issued in one or both of the latter-filed applications.

CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. If any issues remain to be resolved in view of this amendment and reply, the Examiner is requested to contact the undersigned by telephone to achieve a prompt disposition thereof.

Respectfully submitted,

Date November 16, 2007

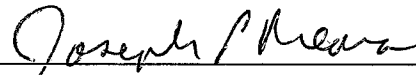
FOLEY & LARDNER LLP

Customer Number: **23524**

Telephone: (608) 258-4303

Facsimile: (608) 258-4258

By



Joseph P. Meara

Attorney for Applicant

Registration No. 44,932